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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,255	09/03/2003	Katsuhiko Matsusaka	009683-481	2789

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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER

HUSSAIN, TAUQIR

ART UNIT	PAPER NUMBER
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2152

NOTIFICATION DATE	DELIVERY MODE
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02/15/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/653,255	MATSUSAKA, KATSUHIKO	
	Examiner	Art Unit	
	Tauqir Hussain	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/21/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed on 11/20/2007. Claims 1-4, 10, 16-17 and 19 have been amended and therefore, claim 1-20 are pending in this application.

Response to Arguments

2. Applicant's arguments filed on 11/20/2007 have been fully considered but they are not deemed to be persuasive. In the remarks, applicant argued in substance that

(a) Iwasaki does not teach "a device that sends folder structure to a client in response to an inquiry from the client".

As to point (a), Iwasaki teaches a registration of document request by having folder path embedded in it, which is send via Email (Iwasaki, [0021]), which means completion of registration is an acknowledgment of file structure by server to a client, as per specification, Fig.6, [0062], file structure is merely a file/folder path e.g. \root folder\Folder A\Folder AA\File AAA).

(b) Applicant argues that there is no motivation to combine the teaching of Iwasaki with the teachings of Mutton.

As to point (b), In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case, Iwasaki register the document via Email and Mutton makes the document available via internet by creating links and distributing to other servers for redundancy purposes.

3. Applicant has challenged the official notice taken by Examiner and demanded the relative art to produce evidence of claimed limitation, which Examiner cited as "well know in the art".

In response to Applicant's challenge Examiner is introducing the prior art "Yukihiro Hibi, PN=12215123) for claims 4-9 and 11-14".

Claims 4-5 and 11-12, Hibi discloses, "sending the folder structure by mail only to the client that is successfully authenticated" (Hibi, [0019], where folder structure is sent to only registered users where registered users have there email embedded in the corresponding certificate).

Claims 6 and 13, Hibi discloses, "using encryption for current log-in indication" (Hibi, [0019], where authentication is determined by a certificate by comparing private and public keys).

Claims 7 and 14, Hibi discloses, "verifying the authentication via encoded encrypted character string that has been previously recorded" (Hibi, [0024], where certificate and registration locations are verified with the defined registration location and pair of certificates at sever and upon verification process proceeds for storing the folder at server).

Claim 8, Hibi discloses, wherein said third transmission portion attaches and sends a file to one mail (Hibi, Fig.2, [0018], where email is segmented in three portions, mail header-202, main text-203 and file attachment-204, file attachment-205 and electronic signature-206).

Claim 9, is rejected for the same rationale as applied to claim 8 above, further it will be obvious to that two attaches files as disclosed by Hibi in a single email can be designated to two different location (Hibi, .

4. Any remark, which is not in claimed language, is not being considered by Examiner.

Response to Amendment

5. Claim rejections under 35 U.S.C. 112 second paragraph have been withdrawn as claims have been amended appropriately.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1, 2, 10, 15 and 17, are rejected under 35 U.S.C 102(b) as being anticipated by Iwasaki et al. (JP 10307826) hereinafter "Iwasaki".

8. As to claim 1, 10 and 17, Iwasaki discloses, a first transmission portion sending a mail from a client to a server for inquiring about folder structure at the server (Iwasaki, [0014], where user transmits the E-mail which request the format inquiring about folder structure of server/host);

a second transmission portion at said server, transmitting the folder structure to said client by mail in response to the inquiry mail sent from said client ([0014], where document management server sends a reply of predefined format);

a third transmission portion at said client (Iwasaki, [0015], where client sends a reply back in response to the received email from server), designating a storage folder in the form of a reply to the mail sent from said server and sending a mail to said server with an attached file ([0015], where client sends the mail back to server with the specified URL or path in the text format for server to acquire the file or folder as an attachment); and

a storage portion, at said server (Iwasaki, [0016], where database means storage portion), storing the attached file in the storage folder as designated, in response to the mail sent from said client (Iwasaki, [0016], where files and folder are stored in plurality of database as specified according to mail from client operator guidance mail of the text format is "attached file" and "acquisitioning" of file is storing the file into specific folder).

9. As to claims 2 and 15, Iwasaki discloses, wherein said second transmission portion sends the folder structure to the client in text format (Iwasaki, [0014], where documentation-management sends its folder structure in text format via email), and

when receiving the folder structure in text format, said third transmission portion designates a storage folder by quoting that text (Iwasaki, [0015], where client/user transmits operator guidance mail of the text format back to the document management server against the reply from the document management server to a designated folder which is described as fixed format).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3, 16 and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki as applied above in view of Mutton et al. (Pub. No.: US 2002/0147840 A1), hereinafter "Mutton".

12. Claim 3-9, 11-14, 16 and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki as applied above in view of Mutton et al. (Pub. No.: US 2002/0147840 A1), hereinafter "Mutton".

13. As to claims 3 and 16, Iwasaki discloses the invention substantially as in parent claims 1 and 10, including, wherein said second transmission portion sends its folder structure to the client (Iwasaki, [0015], where document management server send the directory structure to client via email). Iwasaki however, is silent on using HTML format

to point to directory structure and when receiving the folder structure in HTML format, said third transmission portion designates a storage folder by clicking the storage folder. However, Mutton discloses, sending the directory structure in HTML format (Mutton, [0072], where hyperlink to the file structure is embedded in email) and said third transmission portion designates a storage folder by clicking the storage folder (Mutton, [0039], where hyperlinks are used to direct the link to appropriate/designated file location).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Iwasaki as applied to claim 1 and 2 above with the teachings of Mutton in order to provide a software for constructing option encoding reference tags for the link servers, thus eliminating the need to learn formal request requirements of the link server.

14. As to claims 4-5 and 11-12, Iwasaki discloses the invention substantially as in parent claim 1 and 10, including, reply from server performs authentication by comparing client information described in the inquiry mail sent from the client with client information as registered (Iwasaki, [0015], where client transmits the operator guidance mail along with the registration which is stored on the server along with the attached document, and sends its folder structure by mail only to the client that is successfully authenticated. An official notice is taken on server sending the directory structure to only authenticated users/clients is well known in the art e.g. any secure web site or in any client server environment it is well known technique to avoid any compromise).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Iwasaki with the encryption technique which is well known in the art in order to enhance the security and privacy over the public network.

15. As to claims 6 and 13, Iwasaki discloses the invention substantially as in parent claim 1 and 10, including, wherein said second transmission portion sends together a character string of information indicative of current log-in when sending the folder structure to the client by mail (Iwasaki, Drawing-2, [0016], where clients email address could be the indicative of current log-in. Iwasaki is silent on using encryption for current log-in indication. Examiner takes to official notice that encryption is a well known technique in the art to make communication more secure on public network.

16. As to claims 7 and 14, are rejected for the same rationale as applied to claim 4 and 5 above and further an official notice is taken that keeping a log for verification of an authentic users or email is well know technique in the art at the time the invention was made.

17. As to claim 8, Iwasaki discloses the invention substantially as in parent claim 1, including, wherein said third transmission portion attaches and sends a file to one mail. Iwasaki is silent on attaching more than one file to the server, however Examiner takes the official notice that attaching more than one files to a single email is well know technique in the art.

18. As to claim 9, is rejected for the same rationale as applied to claim 3 and 8 above.

19. As to claims 18 and 20, Iwasaki discloses the invention substantially as in parent claim 17, including, wherein processing is changed in accordance with a title of a mail sent from the client (Iwasaki, Drawing-2, where action defines the required processing).

20. As to claim 19, is rejected for the same rationale applied to parent claim 17 above.

Examiner's Note: Examiner has cited particular columns and line numbers in the references, as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tauqir Hussain whose telephone number is 571-270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571 272 3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH
01/28/2008

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke with a diagonal slash at the end.

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER